



DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No.: PTO-P-2021-0010]

Submitting Patent Applications in Structured Text Format and Reliance on the Text Version as the Source or Evidentiary Copy

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) is in the process of transitioning to a system that supports submitting new patent applications in structured text, specifically DOCX format. Filing in structured text allows applicants to submit their specifications, claims, and abstracts in text-based format, thereby eliminating the need for applicants to convert applications into a PDF for filing. It also provides a flexible format with no template constraints and improves data quality by supporting original formats for chemical formulas, mathematical equations, and tables. The USPTO previously stated that for applications filed in DOCX, the authoritative document would be the accompanying PDF that the USPTO systems generate from the DOCX document. In response to public feedback, however, the USPTO now considers the DOCX document filed by the applicant to be the authoritative document. Accordingly, an applicant who files or has filed an application in DOCX may rely on that version as the source or evidentiary copy of the application to make any corrections to the documents in the

application file. The USPTO will be hosting DOCX training sessions to provide more information, demonstrate how to file and retrieve DOCX files in Patent Center, EFS-Web, and PAIR, and answer any questions. Applicants can also file test submissions through Patent Center training mode to practice filing in DOCX. In addition, we will be offering listening sessions to gather feedback and suggestions to further improve DOCX features.

DATES: *Effective date:* **[INSERT DATE OF PUBLICATION IN THE *FEDERAL REGISTER*].**

FOR FURTHER INFORMATION CONTACT: Mark O. Polutta, Senior Legal Advisor, 571-272-7709, or Eugenia A. Jones, Senior Legal Advisor, 571-272-7727, of the Office of Patent Legal Administration, Office of the Deputy Commissioner for Patents.

For technical questions related to submitting documents in DOCX format, please contact the Patent Electronic Business Center (EBC) at 1-866-217-9197 (toll-free), 571-272-4100 (local), or ebc@uspto.gov. The EBC is open from 6 a.m. to midnight, ET, Monday through Friday.

SUPPLEMENTARY INFORMATION: The USPTO is in the process of transitioning to a system that supports submitting new patent applications in structured text, specifically DOCX format. Application documents submitted in DOCX format will facilitate the examination and publication processes. This notice provides information on structured text filing. Specifically, the USPTO now considers the DOCX documents filed by applicants to be the authoritative document, otherwise referred to as the source or

evidentiary copy of the application, for purposes of determining the content of the application as originally filed, should a discrepancy be discovered. This notice does not require patent applicants to make any changes to their practices.

Currently, applicants may electronically file an application either by submitting PDF files or by submitting DOCX files. If an applicant submits DOCX files, the USPTO uses the DOCX files to generate PDF files prior to the actual filing of the application. The USPTO published a final rule on setting and adjusting patent fees on August 3, 2020. *See* Setting and Adjusting Patent Fees During Fiscal Year 2020, 85 FR 46932 (Aug. 3, 2020). In addition to establishing a fee for applications not submitted in a DOCX format, the response to comment 54 in the final rule stated that for applications filed in DOCX, the authoritative document will be the accompanying PDF that the USPTO systems generate from the DOCX document. *See id.* at 46957.

In response to public feedback, the USPTO has changed what will be the authoritative document. The USPTO is informing applicants that it now considers the DOCX documents filed by applicants to be the authoritative document, otherwise referred to as the source or evidentiary copy of the application. This change applies to all patent documents submitted in DOCX format, including DOCX submissions made prior to this notice.

The source or evidentiary copy of the application is the version submitted to the USPTO by the applicant in one of the following formats: paper, DOCX, or PDF when not accompanied by a DOCX version of the same. Applicants should not submit PDF versions they created when filing an application in DOCX, as they are unnecessary. If the applicant submits documents in DOCX along with PDF versions they created (not the

auto-generated PDFs created by the USPTO), then the DOCX version will still be considered the source or evidentiary copy, and the applicant will be required to pay the non-DOCX surcharge fee.

Applicants can rely on the DOCX version as the source or evidentiary copy in order to make any corrections to the record when any discrepancies are identified between the source or evidentiary copy and the documents as converted by the USPTO. Accordingly, during the filing process, applicants will be advised to review the DOCX files before submission rather than reviewing the USPTO-generated PDF version, as set forth in the August 3, 2020, final rule.

However, applicants are advised to check the USPTO-generated versions as soon as practicable for any discrepancies or errors. Any discrepancies or errors that occur as a result of filing an application in DOCX format should be promptly brought to the attention of the USPTO. Applicants should initially contact the Patent EBC for investigation at 1-866-217-9197 (toll-free), 571-272-4100 (local), or ebc@uspto.gov. Depending on the situation, applicants may need to file a petition under 37 CFR 1.181 in order to have the issue reviewed and addressed. This is consistent with current USPTO procedures for documents filed in patent applications.

In this regard, the USPTO has a records retention schedule for documents it receives, including new patent applications and correspondence filed in patent applications. For example, applications filed in paper via mail or hand-delivery are scanned into the image file wrapper (IFW) or the Supplemental Complex Repository for Examiners (SCORE), as appropriate. In 2011, the USPTO established a one-year retention policy for patent-related papers scanned into the IFW or SCORE. *See* Establishment of a One-Year

Retention Period for Patent-Related Papers That Have Been Scanned Into the Image File Wrapper System or the Supplemental Complex Repository for Examiners, 77 FR 3745 (Jan. 25, 2012). After the expiration of the one-year period, the USPTO disposes of the paper unless the applicant, patent owner, or reexamination party timely files a *bona fide* request to correct the electronic record of the paper in IFW or SCORE. DOCX submissions will be treated similarly. Therefore, the procedure to correct any discrepancies or errors that occur as a result of filing an application in DOCX format will align with the established procedure for an applicant, patent owner, or reexamination party to request corrections to the electronic record when there is an error caused by the USPTO in scanning papers into the IFW.

Applicants should promptly review the electronic record of an application and file any request to correct the electronic record based on the source or evidentiary copy as soon as possible after the document has been submitted to the USPTO. Applicants should not expect to have a request to correct the electronic record granted if the request is based on the source or evidentiary copy and it is filed more than one year after submission of the document. Documents submitted by applicants in PDF or DOCX in patent applications will be treated in a similar manner to papers that have been scanned into the IFW in that they may be disposed of after a period of time if they are the source or evidentiary copy.

The USPTO's procedures regarding national security classified documents are unaffected by this notice. National security classified documents must be filed in the USPTO in paper format via hand-delivery to Licensing and Review or by mail in compliance with 37 CFR 5.1(a) and Executive Order 13526 of December 29, 2009, or in electronic format via the Department of Defense Secret Internet Protocol Router Network (SIPRNET). See section 115 of the Manual of Patent Examining Procedure (MPEP, Ninth Edition,

Revision 10.2019). National security classified documents filed electronically via SIPRNET are maintained at the USPTO in paper form; an electronic record of such documents is not maintained. Thus, all national security classified documents filed with the USPTO are maintained only in paper form, and the paper copies of these documents are the source or evidentiary copies.

Andrew Hirshfeld,

Commissioner for Patents, Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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